

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) P18387/1020P18387	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>February 12, 2010</u> Signature <u>/Spencer A. Bartl/</u> Typed or printed name <u>Spencer A. Bartl</u>		Application Number 10/812,648 Filed March 29, 2004 First Named Inventor Jose Ramirez II Art Unit 2419 Examiner Hicham B. Foud	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <div style="display: flex; justify-content: space-between;"> <div style="width: 45%;"> <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. <u>61, 875</u> Registration number <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____ </div> <div style="width: 45%; text-align: right;"> <u>/Andrew H. Aurand/</u> Signature <u>Andrew H. Aurand</u> Typed or printed name <u>724-364-3245</u> Telephone number <u>February 12, 2010</u> Date </div> </div> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below".</p>			
<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.			

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.	:	10/812,648	Confirmation No.:	3409
Applicant	:	Jose Ramirez II et al.		
Filed	:	March 29, 2004		
TC/A.U.	:	2419		
Examiner	:	Hicham B. Foud		
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Customer No.	:	57035		

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

In response to the Final Office Action mailed on November 12, 2009, with the three-month shortened statutory period for response set to expire on February 12, 2010, Applicants respectfully request review prior to the filing of an Appeal Brief.

REMARKS

Summary

Claims 21-24 and 26-37 stand in this application. Claims 1-20, 25 and 38 were previously canceled without prejudice. No new matter has been added. Favorable reconsideration and allowance of the standing claims are respectfully requested.

Claim Rejections - 35 U.S.C. § 103

Claims 21-23, 25-28, 30-32, 34-36 and 38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 6,188,898 to Phillips (hereinafter "Phillips") in view of United States Publication No. 2003/0235167 to Kuffner

(hereinafter "Kuffner"). Claims 24, 29, 33 and 37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 6,188,898 to Phillips (hereinafter "Phillips") in view of United States Publication No. 2003/0235167 to Kuffner (hereinafter "Kuffner") and further in view of United States Patent No. 6,167,032 to Allison et al. (hereinafter "Allison"). Applicants respectfully traverse the rejections, and requests reconsideration and withdrawal of the obviousness rejections.

Applicant respectfully submits that the cited references, taken alone or in combination, fail to teach or suggest every element recited in claims 21-24 and 26-37. Therefore claims 21-24 and 26-37 define over the cited references whether taken alone or in combination. For example, claim 21 recites the following language, in relevant part:

a beacon transceiver to transmit a beacon to a remote device and to receive a reply from the remote device, wherein a beacon transmitted by said beacon transceiver provides an indication of the one or more available radio communication protocols and a received reply from the remote device provides an indication of a desired radio communication protocol.

According to the Office Action, the missing language is disclosed by Phillips at column 3, lines 20-25 and column 2, lines 1-5. Applicant respectfully disagrees.

Applicant respectfully submits that Phillips fails to disclose the missing language of the claimed subject matter. For example, Phillips at the given cites, in relevant part, teaches:

...the network including a plurality of multimode base stations each capable of operating selectively in at least some of said operating protocols and each having means for interrogating a said mobile terminal so as to determine that terminal's operating protocol....

In the network of FIG. 1, the base stations operate at appropriate frequencies to provide a communications service and also provide a beacon function for those mobile communications protocols that require such a function. For example, the system may provide access to mobile terminals using the GSM 900, DECT, and DCS 1800 protocols. It will be understood that this group of protocols is by no means exclusive and that other existing or future protocols can be accommodated.

Applicant submits that this is different than the above recited language of amended independent claim 21.

Applicant submits that the cited portions of Phillips, arguably, teach means for determining a terminal's operating protocols where the protocols may include GSM 900, DECT and DCS 1800. Applicant submits, however, that they have been unable to locate any teaching in Phillips directed to a beacon transceiver to transmit a beacon to a remote device...wherein a beacon transmitted by said beacon transceiver provides an indication of the one or more available radio communication protocols... as recited in amended independent claim 21. By way of contrast, Applicant submits that Phillips actually teaches away from the use of a beacon transmitting by the base station to initiate communications between a base station and a mobile terminal. More particularly, Phillips at column 3, lines 35-55, arguably teaches that a mobile terminal initiates a call and emits a request for service which is used by the network and/or a base station to determine the appropriate protocol to establish a call between the mobile terminal and the base station. Applicant submits that this is clearly different than the above recited language of amended independent claim 21 that includes a beacon first sent to a remote device by a wireless access point.

Applicant submits that they have been unable to locate at least the above recited language of amended independent claim 21 in the teaching of Phillips. Therefore, Phillips fails to disclose, teach or suggest the missing language. Furthermore, Applicant submits that Kuffner and Allison also fail to teach at least the above recited missing language. Consequently, the cited references, whether taken alone or in combination, fail to disclose, teach or suggest every element recited in claim 21.

Absence from the cited references of the above-mentioned claim elements negates obviousness. For at least these reasons, Applicant submits that claim 21 is patentable over the cited references, whether taken alone or in combination. In addition, claims 26, 30 and 34 recite features similar to those recited in claim 21. Therefore, Applicant respectfully submits that claims 26, 30 and 34 are not obvious and are patentable over the cited references for reasons analogous to those presented with respect to claim 21.

Accordingly, Applicant respectfully requests removal of the obviousness rejection with respect to claims 21, 26, 30 and 34.

Furthermore, if an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is non-obvious. *See* MPEP § 2143.03, for example. Accordingly, Applicant respectfully requests withdrawal of the obviousness rejection with respect to claims 22-24, 27-29, 31-33 and 35-37 that depend from claims 21, 26, 30 and 34 respectively, and therefore contain additional features that further distinguish these claims from the cited references.

Claim Rejections - 35 U.S.C. § 112

Claims 21-24 and 26-37 stand rejected under 35 U.S.C. § 112. Applicant respectfully traverses the claim rejections. Applicant respectfully submits that the limitation “the one or more available radio communication protocols” in line 15 of claim 21 has sufficient support at least at line 5 of claim 21 that recites “at least two or more radio communication protocols...” Similar support can also be found in claim 34. Therefore, withdrawal of the § 112 rejections is respectfully requested.

Objections to the Claims

Claims 21-24 and 26-37 stand objected to. Applicant respectfully traverses the claim objections. Applicant respectfully submits that recited claim objections recite suggested changes and that no amendments are required at this time. Therefore, withdrawal of the claim objections is respectfully requested.

Conclusion

It is believed that claims 21-24 and 26-37 are in allowable form. Accordingly, a timely Notice of Allowance to this effect is earnestly solicited. Further, Applicant submits that the above-recited novel features provide new and unexpected results not recognized by the cited references. Accordingly, Applicant submits that the claims are not anticipated nor rendered obvious in view of the cited references.

Applicant does not otherwise concede, however, the correctness of the Office Action's rejection with respect to any of the dependent claims discussed above. Accordingly, Applicant hereby reserves the right to make additional arguments as may be necessary to further distinguish the dependent claims from the cited references, taken alone or in combination, based on additional features contained in the dependent claims that were not discussed above. A detailed discussion of these differences is believed to be unnecessary at this time in view of the basic differences in the independent claims pointed out above.

The Examiner is invited to contact the undersigned at 724-364-3245 to discuss any matter concerning this application.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. § 1.16 or § 1.17 to the credit card in the previously filed credit card authorization form.

Respectfully submitted,
KACVINSKY LLC

/Andrew H. Aurand/

Andrew H. Aurand, Reg. No. 61,875
Under 37 CFR 1.34(a)

Dated: February 12, 2010

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